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PTO/SB/33 (07-05)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Docket Number (Optional)
29250-000485/US

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number
09/722,576Filed
November 28, 2000

On _____

First Named Inventor
Gaspar HERNANDEZ, III

Signature _____

Art Unit
2193Examiner
Lawrence J. SHRADER

Typed or printed name _____

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages of attachments are provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 37,275.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.



Signature

Thomas S. Auchterlonie
Typed or printed name

703-688-8000
Telephone number

October 27, 2005
Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Typed or Printed Name of Person Signing Certificate

Applicant: Gaspar HERNANDEZ, III

Examiner: SHRADER, L. J.

Application No.: 09/722,576

Group: 2193

Filed: November 28, 2000

Att'y Docket No.: 29250-000324/US

For: WEB-BASED TESTING OF WIRELESS SYSTEM

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Mail Stop AF

September 19, 2005

ATTACHMENT TO FORM PTO/SB/33 ("PRE-APPEAL BRIEF REQUEST FOR REVIEW")

Dear Sir:

As an attachment to the Form PTO/SB/33 ("Pre-Appeal Brief Request For Review") filed concurrently with this document, the following remarks are submitted in connection with the above-identified patent application under the Pilot Program for Pre-Appeal Brief Conference (Off. Gaz. Patent & Trademark Office, Vol. 1296, No. 2, July 12, 2005).

Claims 1-33 are pending in the above-identified application. Of those, claims 1, 13, 20-24 and 26 are independent.

FIRST REJECTION FOR WHICH CONF. REQUESTED

A Pre-Appeal-Brief Conference is requested to review the rejection¹ of claims 1 and 13² under 35 U.S.C. § 103(a) as being unpatentable for obviousness over U.S. Patent No. 6,598,023

¹ See pages 3-11, Final Office Action mailed July 27, 2005, as well as pages 21-22 for the Examiner's statements in rebuttal to the response filed April 25, 2005.

See also the additional rejections under §103(a) for which the '023 patent is the primary reference. None of the references used to modify the '023 patent can be considered a teaching of the noted distinctions thereover. Hence, such other rejections similarly are improper.

² And claims 2, 3, 7, 10, 14-15, 17 and 20-23 dependent on claims 1 and 13, respectively.

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to Drummond et al. (the '023 patent) in view of U.S. Patent No. 6,336,072 to Takayama et al. (the '072 patent). Applicant traverses.

ARGUMENT NO. 1

The gist of the Examiner's position appears to be that the following two descriptions are the same:

PARAPHRASED CLAIM 1,³ TAKEN AS AN EXAMPLE

a browser that receives a set of commands that are to be contained in a script or program and transmits the same.; and

ASSERTED COMBO OF '023 PATENT & '072 PATENT⁴

a browser which receives a URL from a user and transmits the same to an HTTP server.

More specifically, the Examiner has interpreted that a URL specifies a protocol, and then has interpreted a protocol as a set of commands. Applicant finds this unreasonable.

Applicant recognizes that an Examiner is charged with giving the broadest reasonable interpretation to the claims.⁵ But "[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach."⁶ A protocol is an agreed-upon format for transmitting data between two devices,⁷ or a special set of rules that end points in a telecommunication connection use when they communicate.⁸ In the mind of the skilled artisan, a protocol is not a set of commands, especially not such a set that is to be contained in a script or program. How can the Examiner persist with an interpretation that is inconsistent with what the skilled artisan would have reached?

See also the additional rejections under §103(a) for which the '023 patent is the primary reference. None of the references used to modify the '023 patent can be considered a teaching of the noted distinctions thereover. Hence, such other rejections similarly are improper.

³ Underlined emphasis added.

⁴ Underlined emphasis added.

⁵ See MPEP § 2111, page 2100-46.

⁶ See MPEP § 2111, page 2100-47 (underlined emphasis added).

⁷ See webopedia.com, specifically the URL <http://www.webopedia.com/TERM/P/protocol.html>.

⁸ See definitions at [whatism.com](http://searchnetworking.techtarget.com/sDefinition/0,290660,sid7_gci212839,00.html), specifically the URL http://searchnetworking.techtarget.com/sDefinition/0,290660,sid7_gci212839,00.html.

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ARGUMENT NO. 2

An aspect of a proper §103 rejection is that "references[,] when combined[,] must teach or suggest all the claimed limitations."⁹ The Examiner has not responded to Applicant's argument¹⁰ that the asserted combination of the '227 patent as modified by the '072 patent would not yield what has been claimed (e.g., as recited in claim 1). Rather, the asserted combination would yield a browser 76 of ATM 12 that receives a URL of a user and set of navigation information (e.g., a departure time, en-route times, an arrival time, a start time, an end time, etc., a departure point, en-route spots, a destination, an intersection, a transfer point, a facility location, etc.), the latter being irrelevant to ATM 12. For example, as received by browser 76 of ATM 12, the set of navigation information is not a set of commands that are to be contained in a script, nor would syntax checking nor execution be performed on the set by ATM 12. How can the §103 rejection be proper when the result of the combination does not present all of the elements of the claim?

SECOND REJECTION FOR WHICH CONF. REQUESTED

A Pre-Appeal-Brief Conference is requested to review the rejection¹¹ of claims 24 and 26 as being anticipated by U.S. Patent No. 6,085,227 to Edlund et al. (the '227 patent).

The gist of the Examiner's position appears to be that the following two descriptions are the same:

PARAPHRASED CLAIM 24,¹² TAKEN AS AN EXAMPLE

a server receiving a request via a remote terminal from a web browser running thereon to execute an executable file resident on the server; and

⁹ See MPEP § 2143, page 2100-129.

¹⁰ See paragraph bridging pages 10-11 of Applicant's April 25th response.

¹¹ See pages 2-3, July 27th Final Office Action, as well as pages 20-21 for the Examiner's statements in rebuttal to Applicant's April 25th response.

See also the additional rejections under §103(a) for which the '227 patent is the primary reference. None of the references used to modify the '227 patent can be considered a teaching of the noted distinctions thereover. Hence, such other rejections similarly are improper.

¹² Underlined emphasis added.

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WHAT '227 PATENT TEACHES¹³

receiving a command, at a server via a web browser, for a previously initialized program running on the server.

Applicant finds this unreasonable. More particularly, (1A) an executable file resident on a server is different than (1B) a previously initialized program running on a server. In a context of (2A) a request to execute (the executable) versus a context of (2B) a command for (the program), the skilled artisan would have understood that (1A) and (2A) describing loading and running an executable, while (1B) and (2B) concern passing one from among a set of commands recognizable by a program that already has been loaded and which is already running.

Applicant is willing to assume for the sake of argument that there might be circumstances in which a result of commands sent by the user via browser 108 (as in the '227 patent) could correspond to a result that would be achieved when (as claimed, e.g., in claim 24) the executable file resident on the server is caused to be executed by the request received at the server via the remote terminal from the web browser. But more than merely a result is claimed.

Rather, steps to achieve such a result also are claimed. And the claimed steps are different than those taught by the '227 patent, as explained above. Moreover, the claimed steps occur at an earlier state in the use of a piece of software resident on a server than what is taught by the '227 patent. Aspects (1B) and (2B) can occur only after aspects such as (1A) and (2A) have occurred. How can the Examiner treat aspects (1A) & (2A) and aspects (1B) & (2B) as being the if they have a sequential relationship?

Applicant recognizes that an Examiner is charged with giving the broadest reasonable interpretation to the claims.¹⁴ But "[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach."¹⁵ The Examiner has run afoul of the latter.

The Examiner states regarding the '227 patent:¹⁶ "the server in fact causes a request from the browser to execute a file on the server." Applicant disagrees. As explained previously,¹⁷ the

¹³ Underlined emphasis added.

¹⁴ See MPEP § 2111, page 2100-46.

¹⁵ See MPEP § 2111, page 2100-47 (underlined emphasis added).

¹⁶ See page 21, Final Office Action mailed July 27, 2005.

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'227 patent passes commands that are part of set of commands recognizable by an already loaded/running program on the server. This is different than a request to execute, i.e., a request to load and run, an executable resident on the server. How can the Examiner persist with an interpretation that is inconsistent with what the skilled artisan would have reached?

CONCLUSION


In view of the above remarks, Appellant requests the Pre-Appeal Brief Conference to find in favor of Applicant's positions and arrange for withdrawal of the above-noted rejections, culminating in the sending of a Notice of Allowance of the pending claims.

Should there be any outstanding matters that need to be resolved in the present application, please contact the undersigned at the indicated telephone number.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Very truly yours,
HARNES, DICKEY & PIERCE, PLC

By



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